

REMARKS

The Pending Claims

Claims 1-22 are currently pending in the application. No claims stand allowed.

Summary of the Office Action

Pursuant to 35 U.S.C. § 121, the Office Action dated April 8, 2004, segregates the claims into two groups and requires an election of one subgroup. Claims 1-3 and 12-22 constitute Group I (a nano-porous metal oxide semiconductor and photovoltaic device) and claims 4-11 constitute Group II (a method of making the nano-porous metal oxide semiconductor). The Action advises that the restriction requirement is proper since the claims of Groups I and II are distinct from one another — the process as claimed (Group II) can be used to make other and materially different products than those described in the claims of Group I, and a search must be undertaken in different classes.

Discussion of Restriction Requirement

Two criteria must be met to establish a requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, *and* (ii) there must be a serious burden on the Examiner if restriction is not required. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions.*” M.P.E.P. § 803 (emphasis added).

In the case at hand, Applicants respectfully traverse the restriction requirement because the Action fails to meet the above-identified criteria. Although the inventions of Group I and II may be patentably distinct from one another, Applicants submit that a single search would provide all prior art relevant to each group due to the overlapping nature of the subject matter claimed therein. For example, in conducting a search for the method of making the nano-porous metal oxide semiconductor of claim 4 (and claims 5-11), one could also search for nano-porous metal oxide semiconductors of the type described in claims 1, 12, and 15 (and claims 2-3, 13-14, and 16-22) because a description of nano-porous metal oxide semiconductors is incorporated into the method claims. It, therefore, would not be unduly

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burdensome for the Office to conduct a single search of prior art relevant to all the pending claims, and examine the claims of Groups I and II together. Withdrawal of the restriction requirement on this basis is respectfully requested.

If the restriction requirement is made final, however, Applicants provisionally elect the claims of Group I (claims 1-3 and 12-22) for prosecution at this time.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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